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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,259	12/12/2005	Johannes Rudolf Jansen	CS-8473/LcA36.323	4111

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BAYER CROPSCIENCE LP  
Patent Department  
100 BAYER ROAD  
PITTSBURGH, PA 15205-9741

EXAMINER
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BARKER, MICHAEL P

ART UNIT	PAPER NUMBER
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1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/528,259

Applicant(s)

JANSEN ET AL.

Examiner

Michael P. Barker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 is/are allowed.
- 6) ☒ Claim(s) 10-12, 15, and 19 is/are rejected.
- 7) ☒ Claim(s) 13, 14, 16, 18 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/17/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

**Claims 1-9** are canceled. **Claims 10-20** are pending. **Claims 10-12, 15, and 19** are rejected. **Claims 13, 14, 16, 18, and 20** are objected to as being dependent on rejected base claims. **Claim 17** is ALLOWED.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on March 17, 2005 was correctly filed. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the IDS was considered by the Examiner. Please refer to Applicant's copy of PTO-1449, submitted herewith.

Note, the following references have been considered but have not been provided by Applicant: Document Nos: **AM, AN, AO, and AP** from *p. 1 of 2*; **AL, AM, AN, and AO** from *p. 2 of 2*.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 10-12, and 15** are rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Patent Publication No. CA 2430683 A1, published June 13, 2002. The '683

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publication discloses compound 114 at p. 84. This compound anticipates the Markush language of **Claims 10, 11, 12, and 15.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Canadian Patent Publication No. CA 2430683 A1, published June 13, 2002.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

***Determining the scope and contents of the Prior Art***

The '683 publication discloses compound 114 at p. 84.

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*Ascertaining the Differences Between the Prior Art and the Claims at Issue*

Hydrogen v. Methyl:

Applicant's instantly claimed invention, specifically **Claim 14**, wherein **R<sup>4</sup>** is other than H differs from the '683 publication by a methyl group at the **R<sup>4</sup>** position. In this instance, the instantly claimed invention, then, substitutes a methyl for the '683 publication's hydrogen in the same position.

*Resolving the Level of Ordinary Skill in the Pertinent Art*

Hydrogen v. Methyl:

It is well established that the substitution of methyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. *In re Wood*, 199 USPQ 137 (1978). Further, the motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 17** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, Claim 19 recites a method for controlling pests comprising, "allowing an effective amount of. . .compounds of formula (I). . .to act on pests and/or their habitat." It is


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uncertain as to how Applicant intends to allow an effective amount of compounds of formula (I) to act. "Allowing. . .to act" is open to interpretation and connotes passivity rather than actively using the compounds of formula (I). Therefore, because "Allowing. . .to act" is open to more than one interpretation, it does not clearly define the metes and bounds of what Applicant regards as the method of using the compounds of **Claim 10**.

### *Telephone Inquiry*

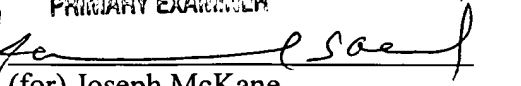
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699. The unofficial fax phone for this group are (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is viable through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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